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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,554	04/08/2004	David H. Tannenbaum	05708/P005DIV/08008819	8358

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DALLAS OFFICE OF FULBRIGHT & JAWORSKI L.L.P.  
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EXAMINER

SALTARELLI, DOMINIC D

ART UNIT	PAPER NUMBER
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2611

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/820,554	<b>Applicant(s)</b> TANNENBAUM, DAVID H.	
	<b>Examiner</b> Dominic D. Saltarelli	<b>Art Unit</b> 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-15, 21-31 and 47-59 is/are pending in the application.
- 4a) Of the above claim(s) 53-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 21-31, 47-52 and 57-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Arguments*

1. Applicant's arguments filed October 6, 2005 have been fully considered but they are not persuasive.

First, applicant argues that the McKissick reference was improperly relied upon, claiming that the subject matter found within McKissick was not made public until after the publication of the Ellis reference (applicant's remarks, page 8).

In response, examiner must note, that under 35 U.S.C. 102(e), the Ellis reference qualifies as prior art, being a publication having a filing date prior to the filing date of the instant application. Further, as shown in MPEP 2163.07(b):

"Instead of repeating some information contained in another document, an application may attempt to incorporate the content of another document or part thereof by reference to the document in the text of the specification. *The information incorporated is as much a part of the application as filed as if the text was repeated in the application, and should be treated as part of the text of the application as filed.*"

Ellis, by incorporating the McKissick document, includes the text found within the McKissick document *as if the text was repeated in the application*. The issue at hand is not the publication date of the Ellis reference, but the effective filing date of the Ellis reference, which was a completed application on June 26,

2000. Therefore, the rejections under 35 U.S.C. 102(e) found herein in view of Ellis stand as presented.

Applicant's arguments regarding 47-49 are moot in view of the new grounds of rejection.

Regarding claim 50, applicant argues that McKissick does not disclose a program transmission source sending start and stop times to recording equipment at the user's premises, claiming McKissick only teaches user control of the recording equipment (applicant's remarks, page 10, first paragraph).

In response, McKissick teaches, on page 30, lines 1-3, having the program guide running on the set top box *automatically* cause a desired program to record, wherein the set top sends start and stop signals to the VCR to control recording (page 13, lines 23-32).

Regarding claim 52, applicant argues that McKissick is silent on adjusting recording times based on time zone changes for the user (applicant's remarks, page 10, second paragraph).

In response, examiner first must note that there is no recitation in the claim that the user's time zone changes, only that the transmission times are adjusted based on the user's time zone. Second, McKissick teaches that the program recording takes place at the appropriate times (page 13, lines 30-32),

and thus it is inherent that said times are adjusted for the user in the manner necessary in order for the user to receive and record the program at the appropriate time, as disclosed.

Regarding claims 53 and 54, as shown below, are directed to a non-elected invention.

Lastly, applicant refers to an IDS submission on October 6, 2005. However, said submission was not properly received, and applicant is respectfully requested to resubmit said IDS for consideration.

***Election/Restrictions***

2. Newly submitted claims 53-56 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The originally filed claims are directed towards a method for allowing a user to receive programs desired by said user utilizing information that is input by said user that pertains to the desired program. Claims 53-56, however, describe a method for controlling the recording of programming by analyzing already recorded programming and making automated decisions regarding programming to record, specifically without any user input.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, claims 53-56 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Claim Objections***

3. Claims 47 and 49 are objected to because of the following informalities: On line 1 of claim 47 and line 1 of claim 49, "recoding" should be changed to --recording--.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-15, 21-31, 50-52, and 59 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US 2004/0117831 A1) [Ellis].

Ellis fully incorporates by reference US application 09/378,533, filed August 20, 1999, to McKissick et al. (shown in paragraph 134, referred to herein as 'McKissick').

Regarding claim 1, Ellis discloses a method for allowing a user to receive programs desired by said user, said method comprising the steps of accepting from said user information pertaining to a program desired to be viewed by said user, matching by other than said user, said accepted information against a list of known programs currently scheduled to be delivered, and informing said user as to when said programs will be delivered (McKissick, page 22 line 28 – page 23 line 15).

Regarding claim 2, Ellis discloses the method of claim 1, wherein said user is allowed to receive said programs at the informed time (McKissick, page 23, lines 16-32).

Regarding claim 3, Ellis discloses the method of claim 1, wherein said program information is selected from future programs (McKissick, page 23, lines 16-17).

Regarding claim 4, Ellis discloses the method of claim 1, wherein upon a non-match condition (McKissick, a “non-frame” program, or a program yet unscheduled, page 16, lines 1-10) making said user request available to at least one content provider (McKissick teaches impulse order for pay-per-view, page 18, lines 30-33, wherein the pay-per-view event has yet to be scheduled, page

24 line 8 – page 25 line 12 and also teaches unscheduled video-on-demand, page 34, lines 3-6).

Regarding claims 5 and 6, Ellis discloses the method of claim 4, wherein an interaction between said content provider and said user delivers content containing said descriptive material [the program that matches said descriptive material] to said user (McKissick, said user actively orders the program using the provided option, page 18, lines 30-33).

Regarding claim 7, Ellis discloses the method of claim 1, wherein upon a non-match condition, continuing by other than said user to match said accepted information against future lists of programs scheduled to be delivered (McKissick, page 27 line 31 – page 28 line 10).

Regarding claim 8, Ellis discloses the method of claim 1, wherein upon a non-match condition continuing by other than said user to match said accepted information against possible future programs not yet scheduled (McKissick, page 15 line 29 – page 16 line 10).

Regarding claim 9, Ellis discloses the method of claim 1, wherein a recorder, at said user's location, is enabled to record said programs when



matched ones of said programs are delivered to said user (McKissick, page 13, lines 23-32 and page 30, lines 1-3).

Regarding claims 10 and 11, Ellis discloses the method of claim 9, wherein the recorder is programmed to start and stop recording at the appropriate times (McKissick, page 13, lines 31-32, wherein the appropriate times must mean the specified program recording time is adjusted in accordance with the location of the user and in accordance with information concerning the actual transmission times of programs being recorded, otherwise the times set for recording would not be the correct times).

Regarding claim 12, Ellis discloses the method of claim 1, wherein said matching step includes comparing a program provider's identity against a permission level set by said TV user (Ellis teaches users set parental controls that block programs, ratings, and channels, paragraphs 196-199).

Regarding claim 13, Ellis discloses the method of claim 1, wherein said matching step includes interacting with said user (McKissick, page 25, lines 13-28).

Regarding claim 14, Ellis discloses the method of claim 1, wherein said accepting step includes accepting said program information over a network

separate from the network used to deliver said desired program (McKissick, page 11, lines 5-19).

Regarding claim 15, Ellis discloses the method of claim 1, wherein said informing step includes informing said user via an electronic message communicated separate from the network used to deliver said desired program (McKissick, page 14 line 32 – page 15 line 8).

Regarding claim 21, Ellis discloses a method for allowing a TV user to receive programs desired by said user, said method comprising:

recording, under control of said user, requests pertaining to a program desired to be viewed by said user, said desired programs not necessarily currently scheduled, either as stand alone programs or programs which are part of a series, for availability to said user (McKissick, page 22 line 28 – page 23 line 15);

accessing recorded ones of said requests by other than said user (McKissick, page 23, lines 6-9);

determining, independent of control by said user, whether or not a program corresponding to an accessed request is currently scheduled so as to be available for delivery to said user (McKissick, page 23, lines 6-15); and

informing said user as to the availability of an accessed request (McKissick, 'reminder list', page 23, lines 12-19).

Regarding claim 22, Ellis discloses the method of claim 21, wherein said user is allowed to receive said programs at the informed time (McKissick, page 23, lines 16-32).

Regarding claim 23, Ellis discloses the method of claim 21, wherein said requests pertain to future programs (McKissick, page 23, lines 16-17).

Regarding claim 24, Ellis discloses the method of claim 21, wherein upon a determination that there are no currently scheduled programs matching an accessed request (McKissick, a "non-frame" program, or a program yet unscheduled, page 16, lines 1-10) making said user request available to at least one content provider (McKissick teaches impulse order for pay-per-view from a content provider, page 18, lines 30-33, wherein the pay-per-view event from the content provider has yet to be scheduled, page 24 line 8 – page 25 line 12, and also teaches unscheduled video-on-demand, page 34, lines 3-6).

Regarding claims 25 and 26, Ellis discloses the method of claim 24, wherein an interaction between said content provider and said user delivers content containing said descriptive material [the program that matches said descriptive material] to said user when said corresponding programs are determined to be available for delivery to said user from said content provider

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(McKissick, said user actively orders the program using the provided option, page 18, lines 30-33).

Regarding claim 27, Ellis discloses the method of claim 21, wherein upon a determination that there are no currently scheduled programs matching an accessed request, continuing for a period of time said accessing, determining, and informing steps (McKissick, page 27 line 31 – page 28 line 10).

Regarding claim 28 and 29, Ellis discloses the method of claims 27 and 21, wherein a recorder, at said user's location, is enabled to record said programs when a match is determined with a subsequently scheduled program (McKissick, page 13, lines 23-32 and page 30, lines 1-3).

Regarding claims 30 and 31, Ellis discloses the method of claim 29, wherein the recorder is programmed to start and stop recording at the appropriate times (McKissick, page 13, lines 31-32, wherein the appropriate times must mean the specified program recording time is adjusted in accordance with the location of the user and in accordance with information concerning the actual transmission times of programs being recorded, otherwise the times set for recording would not be the correct times).

Regarding claim 50, Ellis discloses a method for allowing a user to receive programs desired by said user, said method comprising:

accepting from said user information pertaining to a program desired to be obtained by said user (McKissick, page 22 line 28 – page 23 line 15);

matching, by other than said user, said accepted information against programs that become available for delivery to said user (McKissick, page 23, lines 10-15 and page 24, lines 8-22 and page 16, lines 1-10); and

sending program recording instructions from a program transmission source (fig. 1, set top box 34, which sends programming to the VCR, page 13, lines 23-32) to equipment at said user's premises (fig. 1, VCR 38), said recording instructions operative for establishing a start and stop time for recording said program when said program is transmitted to said user (page 13, lines 23-32 and page 30, lines 1-3).

Regarding claim 51, Ellis discloses the method of claim 50, wherein said user is informed as to when said program will be transmitted (McKissick's 'notification reminders', page 23 lines 16 – page 24 line 7).

Regarding claim 52, Ellis discloses the method of claim 51, wherein the recorder is programmed to start and stop recording at the appropriate times (McKissick, page 13, lines 31-32, wherein the appropriate times must mean the

specified program recording time is adjusted in accordance with the location [time zone] of the user, else it would not be the appropriate time).

Regarding claim 59, Ellis discloses the method of claim 50, including transmitting for recording on said user's equipment matched ones of said program in accordance with sent ones of said recording instructions (an inherent feature, as the established start and stop times in the recording instructions are those provided by a content provider as to when a particular broadcast program is broadcast, and thus supplied from the set top to the VCR).

6. Claims 47-49, 57, and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Marsh et al. (6,208,799).

Regarding claims 47-49, Marsh discloses a method of adjusting recording time of an entertainment program, said method comprising:

selecting an entertainment program to be communicated to said user's premises, said program having scheduled start and stop times (col. 7, lines 11-18);

establishing a start and stop time in accordance with said scheduled start and stop times for recording said selected program at said user's premises (according to the most current IPG data, col. 7, lines 45-48); and

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without action taken by said user, adjusting said established start and stop times of said established recording time to accommodate subsequent changes in program communication times (col. 5 line 50 – col. 6 line 3).

Regarding claims 57 and 58, Marsh discloses the method of claims 47 and 49, including transmitting for recording at said user's premises said selected program in according with said established start and stop times (an inherent feature, as the established start and stop times are those provided by a content provider as to when a particular broadcast program is broadcast).

### ***Conclusion***

7. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The following are suggested formats for either a Certificate of Mailing or Certificate of Transmission under 37 CFR 1.8(a). The certification may be included with all correspondence concerning this application or proceeding to establish a date of mailing or transmission under 37 CFR 1.8(a). Proper use of this procedure will result in such communication being considered as timely if the established date is within the required period for reply. The Certificate should be signed by the individual actually depositing or transmitting the correspondence or by an individual who, upon information and belief, expects the correspondence to be mailed or transmitted in the normal course of business by another no later than the date indicated.



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## Certificate of Mailing

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Please refer to 37 CFR 1.6(d) and 1.8(a)(2) for filing limitations concerning facsimile transmissions and mailing, respectively.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dominic D. Saltarelli whose telephone number is (571) 272-7302. The examiner can normally be reached on Monday - Friday 7:00am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dominic Saltarelli  
Patent Examiner  
Art Unit 2611

DS



**CHRISTOPHER GRANT**  
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